

Remarks

The Examiner required restriction of claims 1-18 to group I drawn to a “bonding tool,” claims 19-24, 31, 23, 35 and 36 to group II drawn to “powder metallurgy methods,” claims 25-30, 33, and 34 to group III drawn to “methods of forming particular semiconductors,” and claims 37- 45 to group IV drawn to a “method of using a bonding tip with resistive heating.”

The Applicants elect the invention of group I with traverse.

The Applicants respectfully submit that the restriction set forth by the Examiner was in error because it failed to properly identify linking claims, in addition to other errors. Additionally group IV is no longer restrictable from group I as a result of the above amendment, even if they were restrictable.

The Examiner stated with regard to the ground for restriction between groups I and II and between groups I and III that “the process can be used to make steel tubes.” However, there are no method steps unique to making steel tubes recited in any of the claims. The method of independent claim 19 of group II from which the claims of group III depend claim a single step of “forming a *bonding tip*” (emphasis added) identical to that of claim 1. Thus any steel tube formed by the method of groups II and III must also be a “bonding tip” identical to that of claim 1. Further, the bonding tips of this invention are often steel tubes (see FIGs. 2 and 3, for example). Thus the Applicants respectfully submit that the claimed product is as much a steel tube as the method for making the product could be used for making a steel tube, and therefore making steel tubes is not a materially different product than the product claimed, contrary to the Examiner’s assertions.

With regard to the ground for restriction between groups I and IV, the Examiner stated that an EFO could be used rather than heating. However, the step of heating has been removed from the claims of group IV making that point moot.

The Examiner characterized groups II and IV as subcombinations usable together. However, as one is a method of making the device of group I and the other is a method of using the device of group I, it is not seen how they can be viewed as subcombinations usable together. Clarification is respectfully requested should the Examiner maintain these two groupings. Neither the method of using nor the method of making contains claims specific to steel tubes. Both independent claim 37 of the method of using and independent claim 19 of the method of making specify bonding with and making the same "bonding tip," which is disclosed as possibly being a tube. Thus the method of using uses steel tube bonding tips to the same extent that the method of making makes steel tube bonding tips, contrary to the implications of the Examiner's assertions.

The Examiner should have identified claims 1-9, 19, and 23-30 as linking claims. Group III should have been identified as linked to group II because all claims in group III depend on claims from group II. Additionally claim 37 is being amended so that claims 37-45 are now also linking claims, if they were not already. Below is a chart showing the correspondence between the three sets of claims.

Device	Method of Making	Method of Using
1	19	37
2	23	38
3	24	39
4	25	40
5	26	41
6	27	42
7	28	43
8	29	44
9	30	45

The three claims in each row are nearly identical except that of the first column is worded as a device, that of the second column is worded as a method of making and that of the third column is worded as a method of using. The only method step of claim 19 is that of “forming” the very same dissipative tip described in claim 1. Similarly, claim 37 differs from claim 1 only in the step of “bonding” using the very same *bonding* tip as in claim 1. The remaining claims in each of the rows are dependent claims that differ from one another only in the preamble of the first column calling the claimed invention a “tip” and of the second and third columns calling the invention a “method,” and in the claim dependence. The MPEP 809.03 (see (B), (C) and (D), in particular) acknowledges that linking claims can exist linking statutory classes of invention such as product, process of making, and process of using. It is difficult to imagine how the limitation of “forming a bonding tip” as recited in claims 19 and 23-30 or of “bonding using a bonding tip” as recited in claims 37-45 warrants a different field of search or in any other way adds any significant burden to the examination of the identical “bonding tip” as recited in claims 1-9. It is also difficult to imagine sets of claims between statutory classes that are more closely linked than those of the present Application.

Since linking claims are examined with the elected invention, claims 19, 23-30 and 37-45 should be examined with the elected invention (the last paragraph of MPEP 809), even if the Examiner maintains the restriction. Therefore, should the Examiner maintain the restriction, the Applicants respectfully request examination of at least claims 19, 23-30, and 37-45 in addition to the elected invention, because these are clearly linking claims.

Respectfully Submitted,
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Date: December 6, 2000

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